

REMARKS

This Amendment is submitted in response to the Office Action dated August 11, 2004. In the Office Action, the Patent Office objected to Claim 27 under 37 CFR §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Further, the Patent Office rejected Claim 27 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Still further, the Patent Office rejected Claims 23-26 under 35 U.S.C. §103(a) as being unpatentable over Riedel (European Patent No. EP 0 465 023) in view of Jensen et al. (U.S. Patent No. 6,592,888).

Applicant notes with appreciation that the Patent Office indicated that Claims 1-22 are in allowable form. Further, Applicant notes with appreciation that the Patent Office approved the drawings which were submitted with the Amendment filed on April 26, 2004.

By the present Amendment, Applicant amended Claims 19, 23 and 27. Applicants amended Claim 19 to correct some minor informalities. Applicant submit that the amendments to the claims overcome the objections and the rejection by the Patent

Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the objection of Claim 27 under 37 CFR §1.75(c), the Patent Office asserts that "Claim 27 depends from Claim 28, which is not present in the instant application." Applicant amended Claim 27 to require "the dressing of Claim 23." Applicant asserts that the amendment to Claim 27 overcomes the objection under 37 CFR §1.75(c). Notice to that effect is requested.

With respect to the rejection of Claim 27 under 35 U.S.C. §112, second paragraph, the Patent Office asserts:

As regards Claim 27, the metes and bounds cannot be determined since the claim depends on a claim not present in the application. Accordingly, prior art comparisons can not be made with regard to Claim 27.

Applicant submits that Claim 27, as amended, depends from independent Claim 23. Applicant asserts that the amendment to Claim 27 overcomes the rejection under 35 U.S.C. §112, second paragraph. Notice to that effect is requested.

The Patent Office rejected Claims 23-26 under 35 U.S.C. §103(a) as being unpatentable over *Riedel* in view of *Jensen et al.* Applicant submits that the rejection has been overcome for the reasons that follow.

In the Office Action, the Patent Office alleges:

As regards Claim 23, *Riedel* discloses a dressing comprising: a semi-permeable film (13) having a top side, a bottom side opposite to the top side, a first edge and a second edge opposite to the first edge; an adhesive layer (14) covering the bottom side of the semi-permeable film; a hydrocolloid adhesive layer (12) attached to the adhesive layer wherein the hydrocolloid adhesive layer has a perimeter; a window (opening) in the hydrocolloid adhesive layer wherein the window is within the perimeter of the hydrocolloid adhesive layer. (col. 2, line 46 - col. 6)

Riedel fails to teach the hydrocolloid adhesive layer is a hydrocolloid silver adhesive layer and that the adhesive layer extends outward with respect to the window beyond the perimeter of the hydrocolloid adhesive layer. However, *Jensen et al.* teach that it is conventional in the art to provide wound dressings with adhesive material comprising both hydrocolloid material and silver because hydrocolloids are highly absorbent and silver is an anti-microbial agent that kills bacteria (col. 3, line 26-col. 4, line 41).

On the contrary, Claim 23, as amended, requires a dressing having a window in the hydrocolloid silver adhesive layer and the adhesive layer wherein the window is within the perimeter of the hydrocolloid silver adhesive layer wherein the window in the hydrocolloid silver is aligned with the window in the adhesive layer.

Riedel merely teaches that "the numeral 10 designates an occlusive dressing in the form of a pad or patch 11 having three layers: a base layer 12, a thin cover layer 13, and an adhesive layer 14." Further, *Riedel* teaches that "base layer 12 is formed from a soft, comfortable, water-absorbing skin barrier material having both wet and dry tack." Further, *Riedel* teaches

that "the base layer 12 has a generally centrally located site-inspection opening 15."

Jensen et al. merely teach dressings for wounds, surgical cuts and other lesions to the human skin with anti-microbial properties. Further, *Jensen et al.* teach a dressing 10 which is applied over an area of skin 5 having a skin opening 50 and that the dressing 10 includes a dressing layer 20 and a backing layer 30.

Neither *Riedel* nor *Jensen et al.*, taken singly or in combination, teach or suggest a window in the hydrocolloid silver adhesive layer and the adhesive layer wherein the window is within the perimeter of the hydrocolloid silver adhesive layer wherein the window in the hydrocolloid silver is aligned with the window in the adhesive layer as required by Claim 23. *Riedel* merely teaches that "such conformability means that portion of the cover layer traversing opening 15 will readily extend to contact with the skin surface and other surfaces visible through opening 15." Further, *Riedel* teaches that "the adhesive layer, combined with cover layer 13, should provide sufficient transparency so that an injection site may be clearly viewed through layers 13 and 14 extending across opening 15. Still further, *Riedel* teaches that "the highly compliant cover film, and the adhesive coating along its underside, contact the

patient's skin that remains visible through opening 15 and, as indicated in Figure 5, such film readily follows the contour of an intravenous catheter 19 at the injection site."

Additionally, the Patent Office admits that "Riedel fails to teach the hydrocolloid adhesive layer is a hydrocolloid silver adhesive layer and that the adhesive layer extends outward with respect to the window beyond the perimeter of the hydrocolloid adhesive layer." Furthermore, Jensen *et al.* merely teaches that "the protective cover layer 30 may be provided as a protective covering for the dressing layer 10 on the side opposite the skin-contacting surface of the dressing 10."

Moreover, with respect to the rejection of Claim 23 under 35 U.S.C. §103(a), one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Riedel* and *Jensen et al.* in the manner suggested by the Patent Office in formulating the rejection of the claim under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the art would suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements

perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

Applicant submits that the Patent Office has merely located components of Applicant's claimed invention. However, that the art disclosed components of Applicant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). No such teaching, suggestion or incentive exists in *Riedel* or *Jensen et al.* to provide the novel features set forth in Applicant's claimed invention. Therefore, one of ordinary skill in the art would never have been motivated to combine *Riedel* and *Jensen et al.*.

Still further, Applicant submits that the Patent Office is merely "piece-mealing" references together providing various teachings and positively defined limitations of Applicant's dressing to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is

impermissible. Since no suggestion exists to modify *Riedel* with *Jensen et al.*, the Patent Office cannot arbitrarily do so to reject the claim. Instead, a reason is required why one skilled in the art would be motivated to make the proposed combination of a primary and a secondary reference. *In re Nomiya*, 184 USPQ 607 (CCPA 1975).

The court in *In re McLaughlin* stated “[T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.” *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 USPQ 2d 1248, 1250 (Fed. Cir. 19789). Since the Patent Office has failed to establish a *prima facie* case of obviousness in combining *Riedel* and *Jensen et al.*, the rejection of Claim 23 under 35 U.S.C. §103(a) is improper.

Furthermore, with the analysis of the deficiencies of *Riedel* and *Jensen et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Applicant’s invention would have

been led to combine *Riedel* and *Jensen et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Even assuming that one having ordinary skill in the art could somehow have combined *Riedel* and *Jensen et al.*, the references still lacks the critical features positively recited in Claim 23. Namely, neither *Riedel* nor *Jensen et al.*, taken singly or in combination, teach or suggest a window in the hydrocolloid silver adhesive layer and the adhesive layer wherein the window is within the perimeter of the hydrocolloid silver adhesive layer wherein the window in the hydrocolloid silver is aligned with the window in the adhesive layer as required by Claim 23. Accordingly, the rejection of Claim 23 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 23-26 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 24-26 depend from independent Claim 23. These claims are further believed allowable over *Riedel* and *Jensen et al.* for the same reasons set forth with respect to their parent claim since each sets forth additional novel features of Applicant's novel dressing.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.


Respectfully submitted,


(Reg. No. 35,018)

Brian M. Mattson
Patents + TMS
A Professional Corporation
1914 N. Milwaukee Ave.
Chicago, Illinois 60647
Telephone: (773) 772-6009
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT AFTER FINAL** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 15, 2004.


Brian M. Mattson (Reg. No. 35,018)